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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	94002611
Party	Applicant Universal Chemical Products Corp.
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Attachments	DOCSLIB-#417640-v2-Joint_Motion_Informing_Settlement.pdf(64806 bytes) Second Addendum to Agreement - Executed.pdf(618162 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

UNIVERSAL CHEMICAL PRODUCTS
CORP.

Applicant,

v.

HUERTA CHEMICAL CORP.

Registrant

CONCURRENT USE NO. 94002611

**JOINT MOTION INFORMING OF SETTLEMENT AND REQUESTING ISSUANCE OF
CONCURRENT USE REGISTRATION AND DISMISSAL OF PROCEEDINGS**

COME NOW the parties, Universal Chemical Products Corp., as Applicant, and Huerta Chemical Corp., as Registrant, and respectfully aver and pray:

1. On September 3, 2015, the parties filed a joint motion informing that they settled this matter pursuant to an Agreement for the concurrent use and registration of Applicant's and Registrant's marks. See 13 TTABVUE. Along with said motion, the parties enclosed a redacted copy of the Agreement. A copy without redactions was submitted for the Board's consideration under seal that same day. See 14 TTABVUE.

2. As explained in the joint motion, per the Agreement the parties agreed that Applicant may use and exercise all rights over the trademark H-7 in Puerto Rico and the U.S. Virgin Islands and may not use, promote, offer for sale, distribute, or sell goods bearing the H-7 trademark in any other part of the United States of America. The parties also set forth that, according to the terms of the Agreement, Registrant may not use, promote, offer for sale, distribute, or sell goods bearing the H-7 trademark in the geographic territory in which Applicant

will exercise its trademark rights in the United States of America (i.e., in Puerto Rico and the U.S. Virgin Islands).

3. On October 20, 2015, the Board issued an order in which it determined that the Agreement was insufficient to avoid a likelihood of confusion, mistake or deception resulting from the concurrent use of their marks.

4. The Board therefore decided to not enter judgment until the terms of the agreement suffice to show that confusion, mistake or deception is not likely to result from the concurrent use of the parties' marks.

5. In light of the Order issued by the Board, the parties executed a Second Addendum to the Agreement, a copy of which is enclosed.

6. The Second Addendum reiterates the specific and exclusive territories of each party, which are not contiguous, are separated by the Atlantic Ocean, and thus reduce the possibility of entry of each party's product into the other's territory.

7. The parties also explain in the Second Addendum that since they have previously agreed to make all reasonable efforts to ensure that no distributors or re-resellers of the goods bearing the H-7 trademark sell outside the territory assigned to each party, consumers within each party's exclusive territory should not have access to the other party's goods bearing the H-7 trademark.

8. The parties further clarify in the Second Addendum that the Agreement submitted to the Board already included a duty not to promote goods bearing the H-7 trademark in each other's territory. As such, pursuant to the terms of the Second Addendum, Registrant agrees not to advertise its goods bearing the H-7 trademark in Puerto Rico or the U.S. Virgin Islands, and

Applicant agrees not to advertise its goods bearing the H-7 trademark anywhere in the U.S. other than Puerto Rico and the U.S. Virgin Islands.

9. The Second Addendum likewise provides that Applicant agrees not to register, attempt to register, or license the H-7 trademark in any foreign countries that are outside the Dominican Republic, Panama and the Lesser Antilles. Meanwhile, Registrant agrees not to register, attempt to register, or license the H-7 trademark in the Dominican Republic, Panama and the Lesser Antilles.

10. The parties also note in the Second Addendum that they have used concurrently the H-7 trademark in their respective territories for over three (3) years and are not aware of any incident of actual confusion.

11. In accordance with the foregoing, the parties request that the Board take into consideration the Second Addendum hereby enclosed, in addition to the Agreement already provided, and issue the concurrent registration sought by Applicant, subject to the referenced geographic limitation of use of the trademark H-7 only in Puerto Rico and the U.S. Virgin Islands and, thereafter, conclude the captioned proceedings.

WHEREFORE, the parties jointly request that the Board take notice of the foregoing and the attached Second Addendum, issue the concurrent registration sought by Applicant subject to the relevant geographic limitation, and conclude these proceedings.

Dated: March 18, 2016

Respectfully submitted,

Attorneys for Registrant:	Attorneys for Applicant:
<p>MALLOY & MALLOY, P.L. 2800 S.W. 3rd Ave. Miami, Fl 33129 Tel. (305) 858-8000 Fax (305) 858-0008</p> <p>S/ OLIVER ALAN RUIZ Oliver Alan Ruiz oruiz@malloylaw.com Florida Bar No. 524,786</p>	<p>PIETRANTONI MÉNDEZ & ALVAREZ LLC Popular Center, 19th Floor 208 Ponce de León Ave. San Juan, P.R. 00918 Tel. (787)274-1212 Fax (787) 274-1470</p> <p>S/MARÍA D. TRELLES-HERNÁNDEZ/ María D. Trelles-Hernández mtrelles@pmaalaw.com USDC-PR Bar No. 225106</p>

SECOND ADDENDUM TO AGREEMENT

THIS AGREEMENT is made by and between Huerta Chemical Corp. (hereinafter "Huerta") a corporation of Florida, having an address of 2360 W. 78 Street, Hialeah FL 33016 US, and Universal Chemicals Products, Corp. (hereinafter "Universal"), a corporation of Puerto Rico, having an address of Amelia Industrial Park, Calle Frances #40, Guaynabo, Puerto Rico. Hereinafter Huerta and Universal are also referred to individually as a "Party" and collectively as "Parties".

The purpose of this Agreement is to acknowledge and confirm the scope and terms of the August 3, 2012 Agreement between the Parties regarding ownership of the rights to the trademark 'H-7' in connection with waterless hand soap and cleaning and degreasing preparation and to enable the parties to each have their own U.S. Registration for the trademark "H-7" with the restrictions already agreed to and the ones set forth herein in accordance with the Trademark Trial and Appeal Board's requirements in Concurrent Use Proceeding No. 94002611.

WHEREAS, the Parties have reached certain agreements regarding the trademark H-7, namely the August 3, 2012 Agreement and February 3, 2015 Addendum to Agreement, each of which is hereby reaffirmed and incorporated by reference;

WHEREAS, Universal has applied for registration of the trademark "H-7" for "*all purpose cleaning preparations; degreasing preparations [not used in manufacturing processes] for cleaning automobile parts; hand soaps*", Serial No. 86/024,066;

WHEREAS, Huerta is the owner of Registration No. 131 6465 for the trademark "H-7" for "*waterless hand soap; cleaning and degreasing preparation*";

WHEREAS, the Trademark Trial and Appeal Board initiated concurrent use proceedings, Proceeding No. 94002611;

WHEREAS, the Parties desire to settle such proceedings and are in agreement that both parties be able to register the trademark "H-7" in I.C. 3, subject to the terms and conditions set forth herein and in the previous August 3, 2012 Agreement and the February 3, 2015 addendum thereto;

NOW THEREFORE, the Parties agree as follows:

1. The Parties have restricted the geographic territories of each other's use of the "H-7" mark in I.C. 3 in the United States of America (U.S.) as follows: Universal is restricted to Puerto Rico and the U.S. Virgin Islands (Universal's Territory) and Huerta is restricted to the remainder of the U.S. (Huerta's Territory).
2. The Parties' respective Territories are sufficiently divided and count with a buffer zone, to wit: the Atlantic Ocean.
3. The Parties do not sell directly to consumers, but rather sell through retailers and/or with the aid of distributors. As such, and given that the Parties have agreed to make all reasonable efforts to ensure that no distributor or re-seller of the goods bearing the H-7 Mark sells outside the Territory assigned to each Party, consumers within each Party's exclusive Territory should not have access to the other Party's goods bearing the H-7 Mark.

- 4. The Parties hereby clarify that their August 3, 2012 Agreement already included a duty not to promote goods bearing the H-7 Mark in each other's Territory. As such, Huerta agrees not to advertise its goods bearing the H-7 Mark in Puerto Rico or the U.S. Virgin Islands, and Universal agrees not to advertise its goods bearing the H-7 Mark anywhere in the U.S. other than Puerto Rico and the U.S. Virgin Islands.
- 5. Universal agrees not to register, attempt to register, or license the H-7 Mark in any foreign countries that are outside the Territory defined in the August 3, 2012 agreement (for ease of reference, the foreign countries included in the definition of the Territory are the Dominican Republic and Panama). Huerta agrees not to register, attempt to register, or license the H-7 Mark in the Dominican Republic and Panama *and the Lesser Antilles - eg. SU*
- 6. The Parties have used concurrently the H-7 Mark in their respective Territories for over three (3) years and are not aware of any incident of actual confusion.
- 7. The Parties agree to notify each other at the addresses set forth at the beginning of this Agreement in case either Party learns of an incident of actual confusion in either Party's Territory, and to engage in best efforts to avoid or cure any incident of actual confusion.

IN WITNESS THEREOF, each of the parties has executed and delivered this Agreement.

HUERTA CHEMICAL CORP.

Signed: [Signature]

Print Name: Neke Alvarez

Print Title: President

Date: 2-16-16

UNIVERSAL CHEMICAL PRODUCTS, CORP.

Signed: [Signature]

Print Name: Javier Vento

Print Title: VP

Date: 2/29/2016